

# **REMARKS**

The Office Action mailed June 9, 2005 has been carefully reviewed and considered. Claims 1-9 and 11-20 are previously pending and all pending claims stand rejected. In the foregoing Amendments, Claims 1, 12, 16 and 20 have been amended to more specifically claim the present invention. Support for these amendments can be found in the specification and the claims of the application as filed. No new matter has been added. Claims 1-9 and 11-20 are currently pending in the application.

Applicants respectfully request entry of the foregoing Amendments and reconsideration of the present application in light of the amendments above and the remarks below.

## The 35 U.S.C. § 103 Rejection

Claims 1-6, 8-9, and 11-20 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Yun<sup>1</sup> in view of well known prior art<sup>2</sup>. Without admitting that Yun is prior art and reserving the right to establish that it is not, this rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

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<sup>1</sup> U.S. Patent No. 6,084,959.

<sup>2</sup> MPEP 2144.03.

art, not in the applicant's disclosure.<sup>3</sup>

Claim 1 of the present invention recites in part:

a ringer option switch, coupled to said microprocessor, having a crescendo setting that signals the microprocessor to generate ringer control signals corresponding to the electric ring signals of the singular incoming telephone call.

(Emphasis added). In other words, a ringer option switch or a slide switch that is coupled with a microprocessor has various ringer options including a crescendo setting. When a user selects the crescendo setting, the ringer option switch signals the microprocessor that it needs to generate ringer control signals in response to the electric ring signals. "A slide switch 212 (or other equivalent switching mechanism) provides a user with options of setting an audible ringing volume of a ring signal." See page 6 of the specification.

Applicants agree with the Office Action's conclusion that Yun does not disclose a ringer option switch. See page 2 of the Office Action. Applicants, however, disagree with the official notice taken by the examiner under M.P.E.P. 2144.03 that it was well known in the art to provide a ringer option switch. Under M.P.E.P. 2144.03, "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicants hereby traverse the assertion and request that a reference be cited in support of the position outlined in the Office Action.

Since Yun does not show all of the claim limitations or equivalents listed in Claim 1 of the present invention, Claim 1 should be patentable over Yun under §103. Since Claims 6, 8 and 11 contain similar limitations as Claim 1, Claims 6, 8 and 11 should also be patentable over Yun under §103. If independent claims are valid, the claims that depend from the independent claims should also be valid as matter of law. See Jenric/Pentron, Inc. v. Dillon Co., 205 F. 3d 1377,

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<sup>3</sup> M.P.E.P § 2143.

1382 (Fed. Cir. 2000). Since Claims 2-5 and 9 depend from allowable independent Claim 1 and 8, respectively, Claims 2-5 and 9 should also be patentable over Yun under § 103.

Applicants further submit that amended Claim 12 recites in part,

A method of providing a telephone ringing signals, comprising:

selecting a gradual increase in audible ringing volume in response to a selection of a crescendo option from a slide switch;

Emphasis added. As discussed earlier, a slide switch or a ringer option switch or any other equivalent switching mechanism can be used to select ringer options including setting an audible ringing volume of a ring signal. See page 6 of the specification. In contrast, Yun has never indicated or mentioned a switch for setting a crescendo option.

M.P.E.P. 2143.03 provides “[t]o establish prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” This is, to have any expectation of rejecting the claims over a combination of references, each and every limitation disclosed in the claim must be disclosed somewhere in the applied prior reference(s). Since Yun fails to disclose a ringer option switch or any equivalent device, Claim 12 can not be obvious in view of Yun under §103. Accordingly, Claim 12 is patentable over Yun under §103. Since Claims 13, 16-17 and 20 contain similar limitations as Claim 12, Claims 12, 16-17 and 20 should also be patentable over Yun under §103. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir. 1988).” See M.P.E.P. §2144.03. Since Claims 14-15 and 18-19 depend from allowable Claims 13 and 16-17, Claims 14-15 and 18-19 should also be patentable.

The Office Action further rejected Claim 7 under 35 USC §103 as being allegedly unpatentable over Yun in view of well known prior art and further in view of the United States

Patent No. 5,870,684 issued to Hoashi et al, hereinafter called Hoashi. Without admitting that Yun and Hoashi are prior art and reserving the right to establish that they are not, this rejection is respectfully traversed.

Claim 7 of the present invention recites in part:

a displayable menu system in communication with said microprocessor, said menu system having a menu key, which when activated provides a user with one or more ringer options, including a crescendo ringing option;

Emphasis added. The menu item from a keypad, in one embodiment, is selectable using a menu key, which when pressed provides the user select options on a LCD display. See page 6 of the present application. In contrast, Hoashi discloses a radio apparatus that resets its initial state if the user of the apparatus responds to an alert tone representative of call incoming. See the Abstract of Hoashi. FIG 3 of Hoashi and its corresponding description at column 3 lines 21 to 35 states that:

the handy phone, generally 100, includes a receiver 101 for receiving a radio signal from a base station, and a transmitter 102 for sending a radio signal to a base station. A memory 103 stores a telephone number assigned to the phone 100 and various numerical values necessary for the control of the phone 100 and including a first reference value which will be described. A controller 104 controls the receiver 101, transmitter 102, memory 103, etc. A speaker 105 outputs a speech signal. A speech signal is input to a microphone 106. A radio signal is received from or sent to the base station via an antenna 107. A call incoming counter 108 counts the number of times of call incoming.

Applicants submit that Hoashi does not disclose or mention a display menu system as claimed in Claim 7. Applicants agree with the conclusion made in the Office Action that Yun does not teach “a displayable menu system in communication with said microprocessor. See page 6 of the Office Action. However, Applicants respectfully disagree with the examiner’s assertion that “it was well known in the art to provide a displayable menu system in

communication with said microprocessor.” See page 6 of the Office Action. Since the Office Action does not provide a specific reference where such a limitation is found, instead arguing that it is well known in the art. Therefore, applicants assume that the Office Action intended to take official notice of facts under M.P.E.P. 2144.03 that the rationale supporting the obviousness rejection is based on common knowledge in the art or "well-known" prior art. M.P.E.P. 2144.03 further states that "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicant hereby traverses the assertion. If this assertion is maintained, Applicants respectfully request, under M.P.E.P. 2144.03(c), that the next office action supplies findings/evidence to support this “well-known” assertion.

Applicants respectfully submit that a desired outcome that the invention provides cannot be used as the motivation to combine the references if there is no such teaching in the references. Since neither Yun nor Hoashi teaches or suggests a combination between Yun and Hoashi, Applicants contend that there is no teaching to combine.

Even assuming for the sake of argument that Yun and Hoashi were combined, the combination would still fail to render the present invention obvious because neither Yun nor Hoashi nor a combination of both discloses or suggests a display menu system that is in communication with a microprocessor to provide a crescendo ringing option. Accordingly, one of ordinary skill in the art would not combine Yun and Hoashi, because even if they were combined, the combination would still fail to disclose or suggest each and every element disclosed in Claim 7. At least for the reason stated above, Claim 7 should be patentable over Yun in view of Hoashi under §103.

Conclusion

Based on all of the above, Applicants believe all claims now pending in the present application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

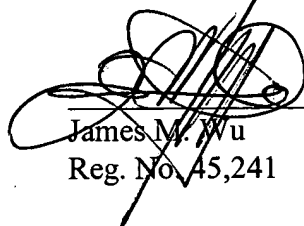
A petition for extension of time for three (3) months is enclosed. No additional fees are believed to be due at this time. However, please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Applicants thank the Examiner for carefully examining the present application and if a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Jim Wu at (408)282-1885.

Respectfully submitted,

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